In the Office Action dated August 24, 2005, claims 1-14, 16-20 and 22-24 stand

rejected. Claims 3 and 9 are amended to clearly point out and particularly claim that the

claimed device can be coupled directly to a USB socket via the USB plug. No new matter is

introduced as a result of these amendments, support for which is found within the

specification as filed. Applicants thank the Examiner for noting the typographic error in the

previous response and confirm that claim 15, rather than claim 14, was being cancelled.

Applicants also thank the Examiner for withdrawing the double patenting rejections of claims

1-22. Applicants respectfully submit that the Examiner's remaining rejections of the pending

claims as set forth in the Office Action have been overcome and that all claims now pending

in the present application are allowable over the cited art for the reasons set forth below.

A.   **Claim Rejections - 35 U.S.C. §§ 102 and 103**

     1.   **35 U.S.C. § 102 – *Bialick***

Claim 1 of the present application recites:

> 1.   A portable device comprising:
> a microprocessor;
> a non-volatile memory coupled to the microprocessor; and
> a biometrics-based authentication module coupled to and controlled by
> the microprocessor, wherein *access to the non-volatile memory is granted to*
> *a user provided that the biometrics-based authentication module*
> *authenticates the user's identity* and wherein *access to the non-volatile*
> *memory is denied to the user otherwise.*

(Emphasis added).

In maintaining the rejection of claims 1, 2, 4, 5, 7, 8, 10, 11, 13-14, 17, 18 and 20

under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,088,802 (hereinafter

"*Bialick*"), the Examiner again cites the discussion at col. 14, lines 50-52 in *Bialick* and

reiterates that "*Bialick* discloses using a biometric authentication method to a host-computing

device before allowing access to particular data stored on the computing device." Applicants

respectfully note that the disclosure in *Bialick* cited above and relied on by the Examiner fails

to teach or disclose, among other things, the claimed limitations "access to the non-volatile

memory is granted to a user provided that the biometrics-based authentication module

authenticates the user's identity" and "access to the non-volatile memory is denied to the user

otherwise" (claim 1), "the microprocessor is configured to disable access to the non-volatile

memory upon a determination of authentication failure by the biometrics-based

authentication module" (claim 7), and "denying the user access to the non-volatile memory

provided that a match is not identified..." (claim 17). This is explained in more detail below.

As Applicants have noted previously, the claim limitations quoted above expressly

require the claimed invention to deny access to the non-volatile memory of the portable

device when the biometrics-based authentication module reports a failed user authentication.

In contrast, as the Examiner stated in both the previous and the present Office Actions, the

discussion at col. 14, lines 50-52 in *Bialick* discloses using a biometric device "to a host

computing device before allowing access to particular data stored on the host computing

device." Applicants respectfully assert that the cited discussion in *Bialick* does not teach or

disclose using a portable device with biometrics-based authentication capability to control

access to memory in the portable device itself and the data stored therein, as required by the

pending claims. Controlling access to data stored in a portable device and controlling access

to data stored in a host computer to which a portable device is connected are two different

goals and involve two distinct endeavors. While it is true that within the scope of the present

invention denial of access to the memory in the portable device can have the *effect* of

restricting access to data stored in a host computing device to which the portable device is

connected, it has no bearing on the patentability of the pending claims. The claims herein are

not directed to a device that grants or denies access to a host computer depending on the

result of user authentication, so even if *Bialick* discloses such a device it would not anticipate

the pending claims. The cited discussion in *Bialick* fails to teach or disclose a portable device that denies access to memory in the portable device. As such, the cited discussion in *Bialick* does not anticipate the claims pending in the present application at least for this reason.

2.   35 U.S.C. § 103 – *Bialick*

The Examiner maintains the rejection of claims 6, 12, 16, 19 and 22 under 35 U.S.C. § 103(a) as being unpatentable over *Bialick*. Applicant respectfully disagrees with the Examiner's reading of the disclosure in *Bialick* and submits that *Bialick* does not render the subject matter of claims 6, 12, 16, 19 and 22 obvious under 35 U.S.C. § 103(a).

With respect to claims 6, 16 and 22, the Examiner cites col. 10, lines 45-47 of *Bialick* and states that *Bialick* teaches using an acceptable access code such as a password or PIN before allowing access. The Examiner also states that it is obvious to modify *Bialick* to provide a bypass mechanism as claimed and that *Bialick* provides the motivation for such modification. Applicants respectfully disagree and point out that *Bialick* teaches "the user must successfully enter an acceptable access code (e.g., a password or PIN) ..." before being allowed access and that it is desirable to "require an access code before enabling the user to use the security functionality ..." (col. 10, lines 46-50). Thus, *Bialick* teaches that the access code be used *in addition to* and *in conjunction with* biometrics-based authentication. In other words, the access code referred to in *Bialick* cannot be a *bypass mechanism*, which by definition is used to *bypass*, or *in lieu of*, the biometrics authentication. As such, Applicants respectfully maintain that claims 6, 16 and 22 are patentable over the cited reference for this additional reason.

With respect to claims 12 and 19, the Examiner cites col. 12, lines 12-13 of *Bialick* and states that *Bialick* teaches encrypting and decrypting data stored on the host-computing device. The Examiner also states that it is obvious to modify *Bialick* to encrypt and store the biometrics marker as claimed and that *Bialick* provides the motivation for such modification.

Applicants respectfully traverse. As the Examiner has pointed out, in the cited discussion *Bialick* teaches encrypting and decrypting *data stored on the host-computing device*. However, the cited discussion in *Bialick* fails to teach or disclose encrypting and decrypting *data stored in the portable device* as required in the claims. While the use of encryption technique to protect confidential information is well known, performing encryption and decryption on data stored within a portable device and performing such operations on data stored in a host computer to which a portable device is connected are different endeavors. Accordingly, Applicants respectfully submit that the cited discussion in *Bialick* does not render the claimed subject matter obvious and maintain that claims 12 and 19 are patentable over the cited reference.

3.   35 U.S.C. § 103 – *Bialick* in view of *Bjorn*

The Examiner maintains the rejection of claims 3 and 9 under 35 U.S.C. § 103(a) as being unpatentable over *Bialick* in view of U.S. Patent No. 6,799,275 (hereinafter *"Bjorn"*). Applicants respectfully disagree with the Examiner's reading of the disclosures in both *Bialick* and *Bjorn* and submit that *Bialick* and *Bjorn*, alone or in combination, fail to teach or disclose various claimed limitations of claims 3 and 9. The Examiner reiterates that while *Bialick* discloses neither a portable device with a USB connector for coupling with another USB-compliant device, nor a portable device with a USB device controller coupled to the bus of the portable device and a USB connector coupled to the bus such that the portable device is capable of communicating with a host platform via the USB connector, *Bjorn* teaches a device with a digital connection, a bus that conforms to a universal serial bus (USB) used to received a digitized image. The Examiner also states that it is obvious to modify *Bialick* to include the USB device controller and USB connector as claimed and that *Bjorn* provides the motivation to do so. Applicants respectfully traverse and submit that the discussion in *Bjorn* about a device with digital connection, a bus conforming to USB and which can receive

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digital images neither teaches or suggests a portable device that has a USB connector which enables the portable device to be coupled directly to a USB socket of another USB-compliant device or a host platform, nor in and of itself suggests or motivates the proposed modification of *Bialick*. As such, claims 3 and 9 are patentable in view of *Bialick* and *Bjorn*, alone or in combination.

4. 35 U.S.C. § 103 – *Bialick* in view of *Estakhri*

Claims 23 and 24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Bialick* in view of U.S. Patent No. 6,385,667 (hereinafter "*Estakhri*"). Applicants respectfully disagree with the Examiner's reading of the disclosures in both *Bialick* and *Estakhri* and submit that *Bialick* and *Estakhri*, alone or in combination, fail to teach or disclose various claimed limitations of claims 23 and 24.

Among other things, Applicants respectfully disagree with the Examiner's assertion that *Bialick* teaches the limitation "the fingerprint module is configured to ... reject a request from the user to access the user data stored in the memory provided that the comparison in said step (2) results in no match" in claims 23 and 24. For the same rationale as discussed above in section A.1, *Bialick* fails to teach or disclose a portable device that rejects a request to access data stored in the memory in the portable device.

Applicants agree with the Examiner that *Bialick* does not disclose the integrated USB plug or the USB controller as claimed. However, the Examiner then cites *Estakhri* for the proposition that it remedies these deficiencies in *Bialick*. The Examiner further suggests that it is obvious to modify *Bialick* to come up with a device as claimed and that *Estakhri* provides the motivation to do so. Applicants respectfully disagree.

Estakhri teaches a very different device than that disclosed and claimed in the present application. *Estakhri* teaches a device that allows different memory cards to be used in conjunction with an interface device to facilitate access to information stored in the memory

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cards. As illustrated in Figure 3, *Estakhri* discloses an interfacing system 300 that can receive a memory card 320 with a 50-pin connection for coupling to a separate interface device 310. Interface device 310 is configurable to various operating modes, each utilizing a different communication protocol. Memory card 320 can likewise be configured to any of various operating modes to match that of interface device 310. When memory card 320 and host computer 335 are connected to interface device 310, host computer 335 can access information stored in memory card 320 via interface device 310. *See, e.g.*, col. 5, line 13 to col. 6, line 24.

The Examiner suggests that *Estakhri* teaches a USB plug integrated into the housing without an intervening cable and capable of coupling the unitary portable data storage device directly to a USB socket on a host computer. Applicants respectfully traverse. As discussed above, *Estakhri* teaches an interfacing system that supports multiple operating modes and communication protocols. However, *Estakhri* does not teach using a USB plug as an integral part of a portable device. Rather, *Estakhri* teaches using a 50-pin connection as a first interface (element 315) for connection to a removable memory card and at the same time using a second interface (element 314), which can support any of a number of different communication protocols. This structure taught in *Estakhri* is inconsistent with having a USB plug. Clearly, *Estakhri* does not teach or disclose a USB plug that is integrated into a portable data storage device, which is a required limitation in the pending claims.

Applicants respectfully traverse the Examiner's position regarding suggestion or motivation to combine the teachings in *Bialick* and *Estakhri*. Specifically, Applicants respectfully submit that the statement in *Estakhri* that the invention therein relates to "interfacing systems facilitating user-friendly connectivity between host computer systems and flash memory cards" (col. 1, lines 16-17) does not provide the requisite suggestion or motivation to modify the teaching in *Bialick* with the teaching in *Estakhri* – even if the two

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references can be combined, which the Examiner suggests and Applicants respectfully traverse – to arrive at the claimed invention in the present application.

The Examiner states that *Bialick* and *Estakhri* are in analogous arts and that it would have been obvious to a skilled artisan at the time of the invention to combine the two references. Applicants respectfully traverse. The fact that *Bialick* and *Estakhri* refer to flash memory and the USB protocol does not, without more, make the two references combinable. Moreover, as discussed above, *Bialick* teaches an access control system that serves to restrict access to information stored in a host computer, whereas *Estakhri* teaches an interfacing system that facilitates access to information stored in multiple memory cards. Thus, Applicants maintain that *Bialick* and *Estakhri* teach two distinct endeavors that seek to achieve opposite results: restricting access to stored information in a host computer versus facilitating access to stored information in multiple memory cards. This is another reason that a skilled artisan would not seek to combine the teachings in *Bialick* and *Estakhri* to come up with the claimed invention in the present application, and that the pending claims are patentable in view of *Bialick* and *Estakhri*.

B.   Conclusion

In view of the foregoing, Applicants respectfully submit that claims 1-14, 16-20 and 22-24 as amended are patentable over the cited art of record. As such, early notification of allowance of claims 1-14, 16-20 and 22-24 is earnestly requested.

The Commissioner is hereby authorized to charge the fees required for the terminal disclaimer and the extension of time under 37 CFR §§ 1.20(d) and 1.136(a), respectively, to White & Case LLP Deposit Account No. 23-1703. Applicants are unaware of any other fees due at this time. However, if other fees are due for any matter concerning this response, the Commissioner is authorized to charge the fees to the above-listed Deposit Account.

Respectfully submitted,

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